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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,518	12/19/2001	David L. Gilmore	OTD-030348-US	6324

7590 01/07/2004

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EXAMINER

MILLER, WILLIAM L

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/025,518

Applicant(s)

GILMORE, DAVID L.

Examiner

William L. Miller

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5, 12-14, 16-18 and 20 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-11, 15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: although the drawings support the sealing surface ends being integrally beveled without any cantilevered component (claim 15), the specification fails to disclose the exclusion of any cantilevered component at the sealing surface ends.

Claim Objections

2. Claims 12, 13, and 16 are objected to because of the following informalities: claim 12, line 8, delete first recitation of “and an adjacent”; claim 13, line 7, change “an adjacent” to “said”; and claim 16, line 9, change “an adjacent” to “said”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 1, 2, 8-10, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Regarding claim 1, the phrase “without any significant bending along said longitudinal axis” constitutes new matter as the original disclosure fails to address the degree of bending (if any) of the seal along its longitudinal axis when compressed to and retained by the supporting tubular member.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaplain (US#3909018).

7. Regarding claim 1, Chaplain discloses a seal assembly for a telescoping joint comprising: a first 10 and second (not shown) nested tubular members slidably mounted with respect to each other and defining an annular space therebetween; and at least one seal 4-7 supported by the first tubular member and sealingly spanning the annular space, the seal having a longitudinal axis and opposed ends and being compressed upon assembly to the first tubular member retaining it in a direction aligned with its longitudinal axis, solely by virtue of insertion of the seal into the first tubular member. While it appears the seal will undergo a degree of bending when compressed to and retained by first tubular member, this assumed degree of being is not being viewed as “significant bending,” a relative term undefined by the applicant.

8. Regarding claim 2, the compression is due to an interference fit in the first tubular member.

9. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Fontenot (US#5184681).

Art Unit: 3677

10. Regarding claim 11, Fontenot discloses a seal assembly for a telescoping joint comprising: a first 14 and second 12 nested tubular members slidably mounted with respect to each other and defining an annular space therebetween; and at least one seal 58 supported by the first tubular member and sealingly spanning the annular space, the seal having a longitudinal axis and opposed ends and being compressed, upon assembly to the first tubular member in a direction aligned with its longitudinal axis, wherein the compression results from an interference fit with portions 67 and 69 of the first tubular member; and the first tubular member including a passage through portions 82,83 thereof to allow a lubricant to be directed from the outside of the annular space to a sealing face 70 of the seal in the annular space via 84.

11. Claims 6 and 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Heinze (US#4793621).

12. Regarding claim 6, Heinze discloses a seal assembly for a telescoping joint comprising: a first 2 and second 1 nested tubular members slidably mounted with respect to each other and defining an annular space 3 therebetween; and at least one seal 12 supported by the first tubular member and sealingly spanning the annular space, the seal having a longitudinal axis and opposed ends and being compressed, upon assembly to the first tubular member and ring 14, in a direction aligned with its longitudinal axis; the compression due at least partially due to an interference fit in the first tubular member; and the seal further comprising a sealing surface (inner surface) having an upper and lower end wherein at least one of the ends, namely end 12b, is beveled with respect to its longitudinal axis.

Art Unit: 3677

13. Regarding claim 15, Heinze discloses a seal assembly for a telescoping joint comprising: a first 2 and second 1 nested tubular members slidably mounted with respect to each other and defining an annular space 3 therebetween; and at least one seal 12 supported by the first tubular member and sealingly spanning the annular space, the seal having a longitudinal axis and opposed ends and the seal further comprising a sealing surface (inner surface) having an upper and lower end wherein at least one of the ends, namely end 12b, is integrally beveled without any cantilevered component with respect to its longitudinal axis.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heinze.

16. Heinze fails to specifically disclose the bevel ranging from greater than 0 degrees to at least about 15 degrees as claimed by the applicant. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the claimed bevel angle range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

17. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chaplain in view of the admitted prior art (APA).

Art Unit: 3677

18. Chaplain fails to disclose the seal is formed of nitrile or polyurethane as claimed by the applicant. However, the APA (lower half of Fig. 1 of instant application) discloses a similar seal assembly wherein seal 10 is formed of nitrile. Therefore, as supported by the APA, it would have been an obvious design choice to utilize a nitrile seal as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Allowable Subject Matter

19. Claims 3-5, 12-14, 16-18, and 20 are allowed.

Response to Arguments

20. Regarding Chaplain, the applicant argues the seal is not under compression along the longitudinal axis thereof without any significant bending along the axis. The examiner disagrees as the seal ends adjacent 14 and 15 are in direct contact with tubular member 2 portions 19 and 20 thereby inherently resulting in compression along the longitudinal axis of seal, namely an axis drawn through the kidney shaped portion of the seal that is parallel to the central axis of tubular member 2. Further, while bending may occur along the axis during compression, it is not being viewed as "significant bending," a relative term undefined by the applicant.

21. The remainder of the applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

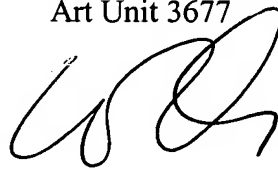
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

Art Unit: 3677

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is 703 872 9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

William L. Miller
Primary Examiner
Art Unit 3677

A handwritten signature in black ink, appearing to be 'WLM', written over the printed name of William L. Miller.

WLM
12-18-2003